REMARKS

Reconsideration of the application is respectfully requested in view of the above amendments and following remarks. Claims 1-46 were pending in the present application. Claims 41-46 are cancelled. New claims 47 and 48 have been added. Claims 1-40 and 47-48 are currently pending.

In the specification, the new paragraph to be inserted on page 1, line 5, was added after the "TITLE OF THE INVENTION" paragraph on page 1, lines 1-3 and before the "FIELD OF INVENTION" paragraph on page 1, lines 5-10, to provide the priority of the present application.

Claims 40-46 directed to Swiss style use claims have been cancelled.

New compound Claim 47 was added. Support for this new claim can be found in Claim 19 and in Example 7 (compound 7-8b) on page 106 of the specification. New Claim 47 depends from Claim 19.

New compound Claim 48 was added. Support for this new claim can be found in Claim 19 and on page 42 of the specification. New Claim 48 depends from Claim 19.

No new matter has been added to the above-captioned application by the amendments or by the addition of the new claims.

RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

The Examiner has required restriction to one of the following inventions:

Group I, Claims 1-24, 30, and 38-40 drawn to products of Formula I and Formula IV, classified in various subclasses of class 544.

Group II, Claims 25-29 and 33-37, drawn to methods of treatment using compounds of Claim 1, classified in various subclasses of class 514.

Group III, Claims 30, 31 and 32, drawn to pharmaceutical compositions for use as treatment, classified in various subclasses of class 514.

Group IV, Claims 41-46, drawn to methods of use of compounds of Claim 1, classified in various subclasses of class 514.

Applicants have cancelled Claims 41-46 of Group IV, which are Swiss Style medicament claims.

Applicants hereby provisionally elect to prosecute the claims of Group I, with traverse.

For proper restriction, two criteria must be met: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803.

Applicants submit that there is no serious burden in combining the restricted groups into one search. A search of the compound claims of Group I would also provide search results relating to the compositions containing the compounds of Group I and methods of using the compounds of Group I. Consequently, would be more efficient for the Examiner to search all of the claims of Groups I, II and III together.

Applicants further submit that the restriction requirement should be removed because Groups I, II and III are linked to form a single invention since the claimed compounds involve a common therapeutic benefit of selectively agonizing the melanocortin-4 receptor and are useful to treat disorders responsive to activation of the melanocortin-4 receptor, such as bulimia, obesity and diabetes. In this case, the Examiner has failed to show how the generic claims in Group I (Claims 1-24, 30, and 38-40) are independent from the method of use claims in Group II (Claims 25-29 and 33-37) and the composition claims of Group III (Claims 30-32). The term "independent" means that there is no disclosed relationship between the two or more subjects disclosed. MPEP 802.01 (August 2001).

Applicants submit that there is a disclosed relationship between the method of treatment claims of Group II and the compound claims of Group I. The method of treatment claims 25-29 and 33-37 of Group II depend from Claim 1 and are drawn to uses for the novel compounds claimed in Group I. In addition, the conditions recited in the method claims are treated by the compounds of Group I via the same mechanism. In this case, the method claims all recite the treatment or prevention of a condition that is alleviated by the agonism of the melanocortin-4 receptor. The method of use claims are therefore not independent.

Applicants further submit that there is also a disclosed relationship between the composition claims of Group III and the compound claims of Group I. The composition Claims 30-32 of Group III depend from Claim 1, and are drawn to compositions that contain the novel compounds claimed in Group I as active ingredients. The composition claims are therefore not independent.

Accordingly, the inventions of Group I, II and III are not independent and Applicants respectfully request that all the claims after the foregoing amendments be examined together.

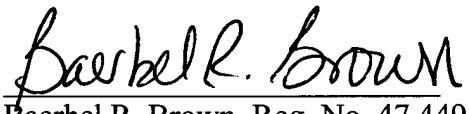
Applicants are required under 35 USC 121 to elect a single disclosed species for prosecution on the merits to which the claims will be restricted if no generic claim is finally held to be allowable. Applicants hereby elect the compound of new Claim 47 as the elected species; the elected species is shown in Example 7 on page 106 of the specification. The following claims read on the elected species: 1, 2, 3, 4, 6, 7, 8, 11, 12, 13, 14, 15, 19 and 25-40.

Applicants make the above election with the understanding that, if the elected species is found to be allowable, the Examiner will examine the genus claims readable thereon and a reasonable number of disclosed species in addition to the elected species. In addition, new Claims 47 (containing the species) and 48 should be examined with the claims of Group I since they are dependent on Claim 1.

In light of the above reasons, Applicants respectfully request that the requirement for restriction between Groups I, II and III be withdrawn. In the event that the restriction requirement is made final, Applicants elect Group I, as indicated, holding Groups II and III in abeyance for further prosecution in a divisional application.

Applicants believe that all of the objections and rejections have been overcome by amendment and/or argument, and therefore earnestly solicit an early Notice of Allowance.

Respectfully submitted,

By 

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September 8, 2005